



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF APPEALS AND INTERFERENCES

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In re application of :
Kanji TAKADA et al. : Group Art Unit.: 1616
Serial No.: 09/787,612 : Examiner: Sharmila S. Gollamudi
Filed: March 20, 2001 :
Title: ORAL DRUG DELIVERY SYSTEM FOR ENHANCING THE
BIOAVAILABILITY OF ACTIVE FORM OF GLYCYRRHIZIN

PETITION UNDER 37 CFR § 1.181

MAIL STOP PETITIONS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

CERTIFICATION OF MAILING	
I hereby certify that this correspondence is being deposited with the U.S. Postal Services as First Class Mail in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on: <u>July 20, 2004</u>	
Name:	Sharon McDaniel
Signature:	<i>Sharon McDaniel</i>
MILLEN, WHITE, ZELANO & BRANIGAN, P.C.	

Concurrently filed with this petition is an Appeal Brief on outstanding appealable issues in this case.

Applicants requested rejoinder of the process of making claims, which are directed to the preparation of the devices of the product claims, in the Reply filed after the final action. In the Advisory Action dated May 4, 2004, the Examiner stated that applicant is "not entitled to rejoinder of the process and product claims since the process claims were introduced mid-prosecution and applicant had already received an action on the originally presented claims (product claims)."

A rejoinder of process claims mandated by MPEP § 821.04, e.g., "process claims which either depend from or include all the limitations of the allowable product will be rejoined," is not dependent on whether the process claims are original claims or entered during prosecution.

MPEP § 821.04, instead of placing such limitation, states that

Where the application as originally filed discloses the product and the process for making and/or using the product, and only claims directed to the product are presented for examination, when a product claim is found allowable, applicants may present claims directed to the process of making and/or using the patentable product by way of amendment. ... Process claims which depend from or otherwise include all the

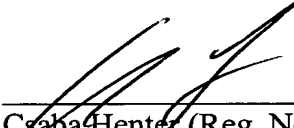
limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance.
(Emphasis added.)

Not only does the MPEP not provide limitations on when a process claim may be entered which depend from or otherwise include all the limitations of the patentable product, but it even allows entry process claims after product claims are found allowable. Prior to final action, e.g., during prosecution, entry of such process claims is guaranteed as a "matter of right." Such claims under the mandate of the MPEP "will be rejoined."

Rejoinder of the withdrawn claims, which rejoinder is proper, is therefore respectfully and courteously requested, upon an allowance of the product claims.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,



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